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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957

No. 605

WILLIAM GOULD, doing business as Stay-Rite Supply Co., and KEYSTONE PLASTICS, INC.,

Petitioners,

vs.

RICHARD A. FISCH and ANCHOR PLASTICS CO., INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

RALPH M. WATSON,
Attorney for Petitioners,
165 Broadway,
New York, N. Y.

HOWARD J. CHURCHILL,
Of Counsel.

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TO THE HONORABLE THE CHIEF JUSTICE AND ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered in the above-entitled case on June 28, 1957; petition for rehearing denied August 13, 1957.

Opinions Below

The opinion of the District Court is reported in 141 F. Supp. 2 and 109 USPQ 344. The opinion of the Court of Appeals is reported in 246 F. 2d 5 and in 114 USPQ 92.

Jurisdiction

The judgment of the Court of Appeals was entered on June 28, 1957. A petition for rehearing was denied on August 13, 1957. The jurisdiction of this Court is invoked under 28 USC, Section 1254 (1).

Question Presented

Did the Court of Appeals, in reversing the District Court's finding of fact that—based upon the prior art disclosures and aided by the expert testimony interpreting the prior art, the process of the patent in suit would have been obvious to a person having ordinary skill in the art—fail to conform to Rule 52(a) of the Federal Rules of Civil Procedure, which states that "findings of fact shall not be set aside unless clearly erroneous", and also fail to follow the decision of this Court in *Graver Tank & Mfg. Co., Inc. et al.* v. *Linde Air Products Co.*, 336 U. S. 271.

Rule of Civil Procedure Involved

Rule 52(a) of the Rules of Civil Procedure is printed in Appendix A. The section of the rule pertinent to the question here presented reads as follows:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

Statement of Case [1]

This is a suit for patent infringement. Federal jurisdiction is based on 28 USC, Section 1338(a).

Respondent, Richard A. Fisch, is the assignee of Seckel patent No. 2,531,234, relating to a "Longitudinally Separable Extruded Thermoplastic Strip and Process of Producing Same". Respondent, Anchor Plastics Co., Inc., is the exclusive licensee. The strips produced under the patent in suit and charged to be infringements are extensively used in the women's garment industry as stays for brassieres, bathing suits, strapless gowns and the like, as substitutes for whale boning, feather boning and steel strips.

The petitioners are William Gould, doing business as Stay-Rite Supply Co., and Keystone Plastics Inc.

The process of the patent in suit (claim 2) consists essentially in admixing a well-known polymeric material or molding composition (cellulose acetate) with another well-known non-compatible polymeric material or molding composition (cellulose acetate butyrate) and extruding the same through a well-known extruder into strip form. Cellulose acetate molding composition was sold commercially by the Tennessee Eastman Company long prior to the invention of the patent in suit under the trade mark Tenite I. Cellulose acetate butyrate was sold commercially as a molding composition by Tennessee Eastman Company long prior to the invention of the patent in suit

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[1] Abbreviations: The transcript of record and the proceedings in the Court of Appeals, Third Circuit, filed herewith, comprises "Appendix to Brief for Plaintiffs-Appellants" (references to this appendix are made as follows: P.-a); "Appendix to Brief for Defendants-Appellees" (references to this appendix are made as follows: D.-a); and a "Supplemental Appendix for Plaintiffs-Appellants" (references to this appendix are made as follows: S.P.-a).

under the trade mark Tenite II. The fact that the two were incompatible was also well known.

The patent in suit, on page 2, column 3, sets forth only one example of how the alleged invention should be practiced, as follows:

> "50 lbs. of commercial cellulose acetate molding powder having a particle size of about ⅛-¼" in diameter are mixed with an approximately equal amount of commercial cellulose acetate butyrate molding powder of approximately the same particle size. As stated above the ratio of the amount of the two powders is not critical. ½ lb. of a pigment such as titanium dioxide is added and the mechanical mixture is introduced into the hopper of a continuous extrusion machine such as shown in Figure 1. The extruded strip has the properties of the strip shown in Figures 2-5 of the drawing. The strip separates substantially completely into threads, i.e., there is no visible portion of the strip which separates into non-fibrous material."

In discussing this one example (P. 95a-96a) Mr. Seckel, the inventor, was asked:

> "Q. So that according to your example, you just mix Tenite I and Tenite II, and run them through an extruder, and you get a strip, and you have practiced the process of this invention, and you have produced the strip of this invention, is that correct?"

To this question he simply replied: "Yes."

Claim 2 of the patent in suit thus calls for nothing more than admixing Tenite I (cellulose acetate) and Tenite II (cellulose acetate butyrate), in any proportions, and extruding the same through a conventional extrusion die. Claim 7 of the patent in suit when similarly summarized calls for nothing more than the strip so produced.

The prior art patents relied upon by the District Court in holding the claims of the patent in suit invalid, as summarized by the District Court, are the following:

> "The Goessling Patent No. 2,353,457, issued July 11, 1944, for 'Synthetic Pearl Resin' discloses the principle of mixing two incompatible thermoplastic resins to produce a resin having an appearance similar to pearl; the pearl effect is achieved by mixing the molding powders of two clear plastics or of one clear plastic and one translucent plastic and heating them in an injection molding machine to produce a molded article."

> "The Jacqué Patent No. 2,185,789, issued January 2, 1940, for 'Thread and Fiber of Organic Thermoplastic Materials and Process of Producing the Same' discloses a process of producing threads from highly polymerized organic materials by forming a thin film of the material and stretching it in the direction of its length."

> "The Malm Patent No. 2,223,376, issued December 3, 1940, for 'Yarn' teaches that a fiber can be made from cellulose acetate butyrate."

> "The Dreyfus Patent No. 2,050,286, issued August 11, 1936, for 'Method of Making Synthetic Straw' teaches the use of cellulose acetate and cellulose acetate butyrate under heat and pressure to obtain a plurality of fibers."

The District Court then found:

> "Such disclosures, especially Goessling's, that two incompatible polymeric materials could be mixed and injection molded to produce a unitary structure with the materials retaining their separate phases anticipated Seckel's mixture and result."

A prior publication was summarized by the District Court as follows:

> "Additionally, a publication entitled Plastics Technology, 'Stretch Orientation of Polystyrene and Its Interesting Results,' written by James Bailey, and contained on pages 225-231 of the May 1934 issue of India Rubber World, discloses that in a fiber-forming polymer which is extruded, the molecules will be aligned in a longitudinal direction."

Petitioners' expert, Dr. R. Leonard Hasche, and respondents' expert, Mr. John M. DeBell, testified at length in interpreting these prior art patents and publication.

The District Court then found as a fact:

> "Based upon such disclosures and aided by the expert testimony interpreting the prior art, the court concludes that it would have been obvious to a person having ordinary skill in the art that cellulose acetate and cellulose acetate butyrate were a fiber-forming polymer, which when extruded individually through a small orifice would form a longitudinal fiber; and it would have been obvious to such a person that the two materials were incompatible so that if they were mixed and extruded they would retain their separate natures even though coalescing into a unit."

The District Court concluded that the patent claims involved were invalid for lack of invention.

The Court of Appeals independently reviewed the prior art patents and publication and found that the patent in suit "produced a new and useful result which called for more than the ingenuity of a mechanic skilled in the art".

Reasons Relied on for Allowance of the Writ

It is respectfully urged that a writ of certiorari should be issued in this case to the Court of Appeals for the Third Circuit for the reasons:

(a) That the decision of the Court of Appeals is in direct conflict with this Court's decision in *Graver Tank & Mfg. Co., Inc. et al.* v. *Linde Air Products Co.*, 336 U. S. 271, wherein this Court, speaking through Mr. Justice Jackson, in a patent infringement case said at page 274:

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations."

On rehearing, the Supreme Court said in 339 U. S. 605 (pp. 609-610):

> "A finding of equivalence is a determination of fact. • • • Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous."

and

(b) That the decision of the Court of Appeals fails to conform to the requirements of Rule 52(a) of the Rules of Civil Procedure, as quoted above.

The trial before the District Court took eight days. In addition to their expert (Mr. John M. DeBell) respondents produced five witnesses. The petitioners called six witnesses in addition to their expert (Dr. R. Leonard Hasche).

Dr. Hasche is a man of outstanding accomplishment in the field of polymeric materials and molding compositions. He was the Director of Research for the Tennessee Eastman Company from 1934 to 1952.

Respondents' expert Mr. John M. DeBell was a contributor to the publication entitled Plastics Technology, "Stretch Orientation of Polystyrene and Its Interesting Results", by James Bailey.

Dr. Hasche, a man admittedly skilled in this art, when discussing the prior art patents relied upon by the District Court to hold the patent invalid testified as follows:

> "Patent No. 2,223,376, Charles J. Malm is the inventor, • • • covers a fiber made from cellulose acetate butyrate." (P. 163a)
>
> "The patent of Goessling, U. S. 2,353,457, • • • is a much discussed patent in this suit of taking two incompatible polymeric materials and injecting them through a die into a cavity in which the pearlescent effect was obtained in the product. • • • Styrene and methyl methacrylate • • • are his preferred materials. • • • he mentions—on page 2, the second column, lines 15 through 17, 'Another such mixture is cellulose acetate butyrate and vinylite • • •' • • • this patent does teach that you can mix cellulose acetate butyrate, a fiber forming material • • • with another fiber forming material." (P. 164a)
>
> "Jacque, U. S. 2,185,789 • • • concerns the preparation of a fiber by breaking up, by friction, a stretched foil into threads. • • • Polyvinyl chloride in example 1 • • • and in example 3 after chlorinated polyvinyl chloride • • • are • • • fiber forming polymers." (P. 165a)

"Dreyfus, U. S. 2,050,286 * * * is drawn to an artificial straw, which is made by coalescing filaments into a bundle. * * * He covers the cellulose esters * * * cellulose acetate * * * cellulose butyrate." (P. 165a-166a)

"Q. Having in mind the teachings of these patents, Dr. Hasche, if you were given the problem, as a man skilled in the art, to produce a strip having longitudinal fibers which could be sewn across, what would you do? A. If it were in the plastic art I would make two incompatible polymers.

"Q. And do what with them? A. Put them through an extrusion die to obtain a coalescent unitary article which would show these properties.

"Q. Would it make any difference whether the two polymers which you selected were fiber forming or not? A. Yes, I think so.

"Q. What type would you select? A. These two examples are very good;* there are many others that could be used, the nylon type with another fiber former, such as ethyl cellulose or vinylite, which would work equally well.

"Q. To produce fibers? A. That's right.

"Q. Because of incompatibility? A. Yes." (P. 193a-194a)

Mr. DeBell, the expert produced by respondents, as a man skilled in this art testified as follows:

In discussing the publication by James Bailey (commencing at P. 117a):

"* * * it was common knowledge prior to the invention of this patent in suit that you could take a fiber forming plastic and run it through an extrusion die and produce a longitudinal thread.* * * the molecules would align end to end and become a thread." (P. 119a)

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* The context indicates he referred to cellulose acetate and cellulose acetate butyrate.

"Q. . . . Now, prior to 1949 you knew, did you not, that cellulose acetate and cellulose acetate butyrate were incompatible plastics? A. Yes." (P. 121a)

"Q. And being incompatible, when admixed, they would remain in their separate phases, is that correct? A. Substantially, yes.

"Q. Substantially in their separate phases. So that if you mix them to form a sheet of material, that sheet of material would be composed of either laminations, or scales, or other orientation of the separate phases of the two materials, is that correct? A. It woud be composed of two phases, yes." (P. 122a)

"Q. Now, in the patent which you say you have reviewed, patent to Goessling, which was issued in 1944, the patentee says, on page 2, second colum, line 9, 'After tests of numerous resin mixtures, I have found the Lucite-styrene mixture to be the best, both as to beauty of pearl appearance and as to strength of structure, but other mixtures have been found to be fully satisfactory. One such mixtures is that of Vinylite (vinyl Chloride) and styrene. Another such mixture is cellulose acetate butyrate and Vinylite.'

"Has it been your experience, sir, that cellulose acetate butyrate and Vinylite are incompatible plastics? A. I have not personally mixed them, but I think they are.

"Q. And if they are incompatible plastics, they would give rise to remaining in separate solid phases, is that correct, when admixed? A. Yes.

"Q. And if extruded they would give rise to separate solid phases during the extrusion, is that correct? A. Yes.

"Q. Are either one of those fiber forming? A. Yes, to some degree they both are, in the extent again that they will make monofils.

"Q. So that both cellulose acetate butyrate and Vinylite are fiber forming plastics and in 1944 Mr. Goessling suggested they could be admixed, even

though incompatible is that correct? A. Surely. That's one of the examples that I was talking about as one of the incompatible jobs which worked.

"Q. And being incompatible you would expect them to remain in their separate phases? A. Yes.

"Q. So that if you wanted to prepare a product which would have separate phases, extruded or otherwise, you would take two of these incompatible plastics and mix them together, is that correct? A. Yes.

"Q. That would be your way of approaching the problem, is that correct? A. As you stated it, yes.

"Q. And if you wanted to get longitudinal fibers you would select those plastics which were known to be fiber forming, is that correct? A. I would certainly start with those." (P. 125a-126a)

The District Court found as a fact that based upon such prior art patents and publication and "aided by the expert testimony interpreting the prior art", the alleged invention of the patent in suit "would have been obvious to a person having ordinary skill in the art".

It is respectfully submitted that in view of this expert testimony interpreting the prior art patents and publication, and the opportunity which the District Judge had to pass upon the credibility of witnesses, the Court of Appeals should not have disregarded this Court's holding in *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co., supra,* and the provisions of Rule 52(a) of the Rules of Civil Procedure, and substitute its own conclusion that the patent in suit "produced a new and useful result which called for more than the ingenuity of a mechanic skilled in the art".

Respondents should not have been accorded a patent monopoly on an admixture of two well-known polymeric materials extruded through the use of a well-known and conventional extruding apparatus, in the face of the District Court's finding that the alleged invention was antici-

pated by the prior art as interpreted by the expert testimony, unless such finding was shown to be clearly erroneous and after due regard had been given to the opportunity of the Trial Court to judge of the credibility of the witnesses, as required by Rule 52(a) of the Rules of Civil Procedure. The Court of Appeals' decision failed to point out that any such clear error appeared in the District Court's finding. On the contrary, the Court of Appeals substituted its own conclusion that the invention of the patent in suit would not have been obvious to a man skilled in the art.

The question is thus presented: Can a Court of Appeals disregard the testimony of expert witnesses who were observed and relied upon by the District Court?

CONCLUSION

For the foregoing reasons, this petition for certiorari should be granted.

Respectfully submitted,

RALPH M. WATSON,
Attorney for Petitioners.

HOWARD J. CHURCHILL,
Of Counsel.

November 8, 1957.

APPENDIX A

Federal Rules of Civil Procedure
Rule 52

Findings by the Court

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b). As amended Dec. 27, 1946, eff. March 19, 1948.

APPENDIX B

RICHARD A. FISCH and Anchor Plastics Co., Inc.,
Plaintiffs-Appellants,

v.

William GOULD, Doing Business as Stay-Rite Supply Co., and Keystone Plastics, Inc., Defendants-Appellees.

No. 12145

United States Court of Appeals
Third Circuit.

Argued May 6, 1957.

Decided June 28, 1957.

Rehearing Denied Aug. 13, 1957.

Action for infringement of patent for longitudinally separable extruded thermoplastic strip and for process producing strip. From judgment of the United States District Court, for the District of New Jersey, Alfred E. Modarelli, J., 141 F. Supp. 2, holding that the patent was invalid for want of invention, the plaintiff appealed. The Court of Appeals, McLaughlin, Circuit Judge, held that the patent was not invalid for want of invention and that it was infringed.

Judgment reversed and cause remanded with directions.

1. Patents—Key 328

Patent No. 2,531,234 for longitudinally separable extruded thermoplastic strip and process for producing strip was not invalid for lack of invention and was infringed.

Appendix B

2. Patents—Key 16.11

The so-called "flash of genius" test is not accepted as a fair standard for judging patentability in the Court of Appeals for the third circuit. 35 U.S.C.A. § 103.

George B. Finnegan, Jr., New York City (Jerome G. Lee, Orville N. Greene, New York City, Pitney, Hardin & Ward, Newark, N. J., on the brief), for plaintiffs-appellants.

Howard J. Churchill, New York City (David Trauth, Newark, N. J., Robert M. Freeman, New York City, on the brief), for defendants-appellees.

Before McLaughlin, Kalodner and Hastie, Circuit Judges.

McLaughlin, Circuit Judge.

[1] The district court held the disputed process patent invalid for lack of invention and plaintiffs appeal.

The patent is United States patent No. 2,531,234 issued November 21, 1950 to Peter H. Seckel. Without contradiction, as set out in the patent, the process consists of melting two or more incompatible thermoplastic fiber-forming linear-polymeric compositions, introducing them into a conventional extruding machine and extruding them into thin linear strips. The two plastics given in the patent example are cellulose acetate and cellulose acetate butyrate. The unitary product obtained consists essentially of two distinct series of parallel threads or fibers adhered together and has a high resistance to breaking as the result of repeated flexing. The strips are very useful as corset stays and similar stiffening reinforcements for

ordinary or protective wearing apparel or in any material which is apt to be subjected to repeated flexing.

The district court concluded from the prior art and testimony interpreting it that the process would have been obvious to a person with ordinary skill in the art. Reliance was placed primarily upon the Goessling Patent No. 2,353,457 issued July 11, 1944, the sole prior art product mentioned by the court resulting from joining two incompatible plastics. It, as the court stated, consisted in "• • • mixing two incompatible thermoplastic resins to produce a resin having an appearance similar to pearl; the pearl effect is achieved by mixing the molding powders of two clear plastics or of one clear plastic and one translucent plastic and *heating them in an injection molding machine to produce a molded article.*" (Emphasis supplied). The result of this as described in the Goessling patent is "• • • a laminated or stratified structure, somewhat resembling that of mica • • •." The Goessling product did have a pearl colored or opaque appearance. Its character as named in the patent itself was "purely decorative." The essential difference between the Goessling structure and the suit patent was that the latter by its extrusion process obtained the flexible longitudinal strips, highly usable in the manner the patent asserted. That use was not only impossible of achievement by the molding method but was not within the contemplation of the Goessling objectives which called for a rigid, brittle, mica like article, the exact opposite of the patent here.

The Jacqué Patent, No. 2,185,789, issued January 2, 1940, referred to by the trial court as prior art, deals with spinning off threads from a single thermoplastic. In the third example given in that patent, by using after-chlorinated polyvinyl in a silk twisting machine "fine threads having a curling like wool" were obtained. There is not the slightest suggestion in this patent of the Seckel process and performance. Nor has the Dreyfus patent, No.

2,050,286, issued August 11, 1936, any indication of Seckel's mixture of incompatible plastics and its end result of a flexible strip composed of internal fibrils. The Malm patent, No. 2,223,376, issued December 3, 1940 deals with a yarn made from cellulose acetate butyrate. There is no combination of plastics, no extrusion of them, no fibrils. Finally, the court alludes to an article by James Bailey which has to do with stretching monofils from a single plastic material, polystyrene. According to the witness DeBell, it is stiff. Asked if the product is flexible he said, "Not until it is broken to pieces." Two other patents referred to by appellees, Carothers, No. 2,071,252 and Dickie and Moncrieff, No. 2,089,947, issued August 17, 1937, render no assistance to the contention that the litigated process was anticipated.

All in all the prior art revealed no hint of combining two incompatible plastics to form a solid mass of fixed fibrils. Indeed appellees' principal argument to us is not so much that the disputed method appears from the above listed prior art but that it derives directly from a procedure in the trade known as "purging". That consists in cleaning extruders by pushing out the balance left of old material with the different material about to be used. This combination, according to witnesses, contaminated both materials and, said the witnesses, on occasion fiber structures were present. The Director of Research at Tennessee Eastman, having noticed this and various blemishes, reported to the president of the company and thereafter warned the trade that cellulose acetate and a butyrate should not be mixed. The net of all that type of testimony was that in "purgings" fibrous characteristics had been observed in material which was spongy, pimply, stringy, under strength, tended to peel off, laminate, shatter and fall apart. The testimony is unimportant in this case. It would be unjust to invalidate this patent on such

flimsy evidence. In passing, we find no word of support for it in the opinion of the district judge.[1]

[2] It is true appellants claimed in their brief to the district court that their invention is a giant stride in the plastics art and that the court held it was "no giant stride". However, we do not think either the assertion or that part of the decision disposing of it was necessary. In this court the so-called flash of genius test is not accepted as a fair standard for judging patentability. Section 103 of the new Patent Act,[2] as we said in one of the earliest cases commenting on it, was intended to codify decisional patent law.[3] "The difficulty" as Judge Kalodner so well stated in his Palmer opinion[4] "always existed in the application of the law, because to a large extent the standards have been indefinite and subjective. And judicial attempts to improvise expressions covering that which had been said many times before account for numerous descriptive phrasings of an elusive concept. The Act was intended to achieve the objective of stabilizing the law through legislative expression which becomes the touchstone of the decisions." One phrase which had found its way into decisions and used largely out of context was "flash of creative genius".[5] The last sentence of Section

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[1] The only reference made by the court to expert testimony at the trial was in connection with the prior art.

[2] 66 Stat. 792, 35 U.S.C. § 103.

[3] Stanley Works v. Rockwell Mfg. Co., 3 Cir., 1953, 203 F.2d 846, 849.

[4] R. M. Palmer Company v. Luden's, Inc., 3 Cir., 1956, 236 F.2d 496, 499.

[5] Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U.S. 84, 91, 62 S.Ct. 37, 86 L.Ed. 58.

103 was directed especially to the elimination of the meaning which in some opinions had been ascribed to that language. The sentence reads: "Patentability shall not be negatived by the manner in which the invention was made." In so endeavoring to bring an end to the misuse of the dangerously attractive phrase, as we see it, there was a real stabilization, a true codification of sound patent law which applied here brings us to the conclusion that the combination in this instance of the incompatible plastics, processed as it is, has produced a new and useful result which called for more than the ingenuity of a mechanic skilled in the art. It was not anticipated by the prior art. It is a worth-while valid invention.

The judgment of the district court will be reversed. The cause will be remanded with the direction to enter judgment in favor of the plaintiff for the admitted infringement and for such other proceedings as may be indicated.

APPENDIX C

Richard A. Fisch and Anchor Plastics Co., Inc., Plaintiffs,

v.

William Gould, trading as Stay-Rite Supply Co., and Keystone Plastics, Inc., Defendants.

Civ. A. No. 285-51.

United States District Court
D. New Jersey.
May 14, 1956.

Action for infringement of patent for longitudinally separable extruded thermoplastic strip and process for producing strip. The District Court, Modarelli, J., held that patent was invalid for want of invention.

Judgment in accordance with opinion.

1. Patents—Key 191

A patent will protect its holder in monopoly over whatever use it is capable of. 35 U.S.C.A. §§ 101, 103.

2. Patents—Key 16

Statute detailing conditions of patentability did not lower standard of invention as set forth in prior judicial decisions. 35 U.S.C.A. § 103.

3. Patents—Key 328

Claims 1, 2, 4, 5 and 7 of Patent No. 2,531,234, for longitudinally separable extruded thermoplastic strip and process for producing strip, were invalid for lack of invention.

4. Patents—Key 325(11)

Under statute providing that court, in exceptional cases, may allow reasonable attorneys' fees in patent cases to prevailing parties, allowance of attorneys' fees is discretionary. 35 U.S.C.A. § 285.

Appendix C

5. PATENTS—Key 325(11)

In action for patent infringement wherein defendants counterclaimed for unfair competition, court found patent invalid for want of invention and defendants conceded that there was insufficient evidence to support counterclaim, evidence failed to show that plaintiffs were guilty of any bad faith or that there were any equitable considerations which would warrant allowing defendants their counsel fees. 35 U.S.C.A. § 285.

Otto Cooper, Union City, N. J., Greene, Pineless, Callmann & Durr, by Orville N. Greene, New York City, of counsel, for plaintiffs.

Smith, Slingerland, Trauth & Holtz, by David Trauth, Churchill, Rich, Weymouth & Engel, by Howard J. Churchill and Robert M. Freeman, New York City, for defendants.

MODARELLI, District Judge.

This is a patent action. Plaintiffs are Richard A. Fisch, who is the assignee of Patent No. 2,531,234 for "Longitudinally Separable Extruded Thermoplastic Strip and Process of Producing Same,"[1] and Anchor Plastics Co., Inc., Fisch's exclusive licensee of the patent. The application for the patent was filed on July 21, 1949, and issued on November 21, 1950, to Peter H. Seckel. Plaintiffs allege that William Gould, trading as Stay-Rite Supply Co.,

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[1] "The thin strips are very useful as corset stays and similar stiffening reinforcements for ordinary or protective wearing apparel or in any material which is apt to be subjected to repeated flexing." Col. 2, line 15. "* * * the strip will withstand an unusual number of * * * severe flexings without separating." Col. 3, line 23. Commercially, the product has been marketed as a brassiere stay known as "Bonar."

and Keystone Plastics, Inc., are infringing the patent by making, using, and selling strips embodying the patented invention and by employing a process for producing the material embodying the patented invention. Plaintiffs demand that defendants be enjoined from infringing and that plaintiffs receive an accounting and damages. The defense is that the patent is invalid for lack of invention; defendants also counterclaim for damages based upon alleged unfair competition by plaintiffs in threatening to sue defendants' customers for infringement.[2]

At the beginning of the trial, plaintiffs limited their charge of infringement to Claims 2 and 7 of the patent. The counterclaim, however, requires an adjudication of all of the claims except numbers 3 and 6, which the parties agree are not involved. Since defendants admit infringement, the only issue is whether Claims 1, 2, 4, 5, and 7 are valid.[3]

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[2] Defendants concede there is insufficient evidence to support their counterclaim; they contend, however, that "Plaintiffs' conduct * * * of trying to dissuade the defendants from contesting the same [this action] by threats against customers, a separate suit against a customer, by notices to the trade and suggestions of disproportionate litigation expenses—having in mind that the patent in suit covers something which is completely devoid of novelty and invention—shows bad faith and warrants the award of counsel fees to defendants under 35 U.S.C.A. § 285." Defendants' Proposed Findings of Fact and Conclusions of Law No. 29.

[3] "1. A process of producing strip material which has a homogeneous appearance but separates into a plurality of filaments when sharply bent comprising the steps of mixing two non-compatible, fiber, forming, linear-polymeric, thermo-plastic materials, plasticizing said mix, and forcing the mix containing two separate solid phases through a single orifice die and withdrawing the extruded product from the die without substantially stretching the same whereby a unitary product consisting essentially of two distinct series of parallel threads adhered together is obtained.

Appendix C

The objects of the patent are: (1) To provide a process for manufacturing a length of extruded material; (2) having unusual longitudinal tensile strength and unusual resistance to tearing transversely with respect to the direction of extrusion; (3) which is easily separable into threads running parallel to the length of the material; and (4) having a very high resistance to breaking as a result of repeated flexing. "These objects and others ancillary thereto are obtained by adding two or more incompatible

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"2. A process of producing strip material which has a homogeneous appearance but separates into a plurality of substantially parallel filaments when sharply bent comprising the steps of mixing cellulose acetate with cellulose acetate butyrate which is non-compatible with said cellulose acetate, plasticizing the mix, and forcing the mix containing two separate solid phases through a die, one phase of said mix comprising a solid fiber-forming material consisting essentially of cellulose acetate and the other phase comprising a solid fiber forming material consisting essentially of cellulose acetate butyrate.

"4. As an article of manufacture, an extruded longitudinal strip of thermo-plastic material, having a homogeneous appearance but actually comprising two chemically distinct solid phases, each of said phases consisting essentially of a fibrillar, linear-polymeric, thermoplastic material which has a similar melting point but which is incompatible with the thermoplastic material of the other phase even when melted, the linear alignment of the individual fibers of each of said thermoplastic materials being substantially parallel and said strip having a substantial thickness whereby when the strip is bent sharply at any point the phases separate into a plurality of layers each containing a multiplicity of filaments, said product being substantially unseparable transversely thereof beyond the filamentary stage by any operation involving only the repeated bending of the strip.

"5. As an article of manufacture, an extruded longitudinal strip of thermoplastic material, having a homogeneous appearance but actually comprising two chemically distinct solid phases, each of said phases consisting essentially of a fibrillar, linear-polymeric, thermoplastic material which has a similar melting point but which is incompatible with the thermoplastic material of the other phase even when melted, the linear alignment of the individual fibers of each of said thermoplastic materials being substantially parallel to

thermoplastic, fiber-forming linear-polymeric compositions[4] to an extruding machine and extruding the two materials to form a unitary product.

"At least two of the thermoplastic materials which are extruded must be fiber-forming material * * * and must be incompatible. Apparently any two of such fiber-forming thermo-plastic materials that are incompatible can be employed although it is obvious that the plasticizing temperatures of the two materials should not be too far apart. The proportions of the incompatible materials are not very critical, the proportion of either one can vary from about 5% to 95% or more, of the mixture. The best mixture so far found is 40-60% of cellulose acetate with 60-40% of cellulose acetate butyrate." Col. 1 line 44.

As set forth in the patent, the process is that a mix comprising two incompatible thread-forming plastic materials is extruded through a die to form a strip, which can

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the length of the strip and said strip having a substantial thickness whereby when the strip is bent sharply at any point the phases separate into a plurality of layers each containing a multiplicity of filaments, said product being substantially unseparable transversely thereof beyond the filamentary stage by any operation involving only the repeated bending of the strip.

"7. As an article of manufacture, an extruded longitudinal strip of thermoplastic material, having a homogeneous appearance but actually comprising two solid phases, one of said phases consisting essentially of cellulose acetate, the other of said phases consisting essentially of cellulose acetate butyrate, said two cellulose derivatives of the two phases being incompatible with each other and each having a fibrillar structure, the linear alignment of the individual fibrils of each of said cellulose derivatives being parallel and said strip having a substantial thickness whereby when the strip is bent sharply at any point the phases separate into a plurality of layers each containing a multiplicity of filaments said product being substantially unseparable transversely thereof by any operation involving only the repeated bending of the strip."

[4] The example set forth in the patent and Claims 2 and 7 disclose the use of cellulose acetate and cellulose acetate butyrate.

be separated longitudinally into a plurality of threads or filaments. Is such a process patentable as a new and useful process, or composition of matter or improvement thereof?[5] Does the patent show " 'more ingenuity • • • than the work of a mechanic skilled in the art.' [Citing cases.]" Sinclair & Carroll Co. v. Interchemical Corp., 1945, 325 U.S. 327, 330, 65 S.Ct. 1143, 1145, 89 L.Ed. 1644, cited in Modern Art Printing Co. v. Skeels, 3 Cir., 1955, 223 F.2d 719. Has there been "• • • an innovation for which society is truly indebted to the efforts of the patentee. • • •" Sinclair & Carroll Co. v. Interchemical Corp., supra, 325 U.S. 330, 65 S.Ct. 1145.

Defendants argue that when Seckel mixed cellulose acetate and cellulose acetate butyrate[6] and extruded it to produce a longitudinally fibrous product his process and product resulted from knowledge obvious to a person having ordinary skill in the art.[7]

Any extrusion of cellulose acetate by itself or of cellulose acetate butyrate by itself always results in a product which is devoid of internal fibers; never, when extruded alone, is the mono-filar filament (non-fibrous) of cellulose acetate or of cellulose acetate butyrate inherently or internally fibrous. The patent discloses that when a mixture of cellulose acetate molding powder and cellulose acetate butyrate molding powder is plasticized[8] and extruded through a single die orifice, the extruded strip automatically and in-

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[5] 35 U.S.C.A. § 101.

[6] Commercially, they are known as Tenite I and Tenite II. Tenite I is a cellulose acetate molding composition sold by the Tennessee Eastman Company since 1934. Tenite II is a cellulose acetate butyrate molding composition sold by the Tennessee Eastman Company since 1938.

[7] 35 U.S.C.A. § 103.

[8] I. e., heated until melted.

herently is internally fibrous. From these facts, plaintiffs conclude that the internal fibrous character of the extruded mixture is an amazingly unexpected result arising from the concomitant extrusion of the plasticized mixture of two incompatible thermoplastics. Plaintiffs ask this court to hold that Seckel's discovery of a new composition of matter of unique, unexpected, desirable properties—an internally fibrous strip—produced by mixing, plasticizing, and extruding cellulose acetate and cellulose acetate butyrate is patentable.

The steps in the patented process are: (a) Mixing two incompatible thermoplastic fiber-forming linear-polymeric compositions; (b) plasticizing the mixture in an extruding machine; and (c) extruding the mixture through a die, the result of which is a longitudinally fibrous strip. Steps (b) and (c) alone and combined are not patentable under the familiar standards set forth in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 1950, 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162; Cuno Engineering Corp. v. Automatic Devices Corp., 1941, 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58; this court's views concerning patentability are set forth in Joseph Bancroft & Sons Co. v. Brewster Finishing Co., D.C.N.J.1953, 113 F.Supp. 714, affirmed 3 Cir., 1954, 210 F.2d 677, and Avery v. Ever Ready Label Corp., D.C.N.J.1952, 104 F.Supp. 913.

Is the mixing described in (a) alone or combined with (b) and (c) to produce the strip sufficient to sustain the patent? The Goessling Patent No. 2,353,457, issued July 11, 1944, for "Synthetic Pearl Resin" discloses the principle of mixing two incompatible thermoplastic resins to produce a resin having an appearance similar to pearl; the pearl effect is achieved by mixing the molding powders of two clear plastics or of one clear plastic and one translucent plastic and heating them in an injection molding machine to produce a molded article. The Jacqué Patent

No. 2,185,789, issued January 2, 1940, for "Thread and Fiber of Organic Thermoplastic Materials and Process of Producing the Same" discloses a process of producing threads from highly polymerized organic materials by forming a thin film of the material and stretching it in the direction of its length. The Malm Patent No. 2,223,376, issued December 3, 1940, for "Yarn" teaches that a fiber can be made from cellulose acetate butyrate. The Dreyfus Patent No. 2,050,286, issued August 11, 1936, for "Method of Making Synthetic Straw" teaches the use of cellulose acetate and cellulose acetate butyrate under heat and pressure to obtain a plurality of fibers. Such disclosures, especially Goessling's, that two incompatible polymeric materials could be mixed and injection molded to produce a unitary structure with the materials retaining their separate phases anticipated Seckel's mixture and result. Additionally, a publication entitled Plastics Technology, "Stretch Orientation of Polystyrene and Its Interesting Results," written by James Bailey, and contained on pages 225-231 of the May 1934 issue of India Rubber World, discloses that in a fiber-forming polymer which is extruded, the molecules will be aligned in a longitudinal direction.

Based upon such disclosures and aided by the expert testimony interpreting the prior art, the court concludes that it would have been obvious to a person having ordinary skill in the art that cellulose acetate and cellulose acetate butyrate were a fiber-forming polymer, which when extruded individually through a small orifice would form a longitudinal fiber; and it would have been obvious to such a person that the two materials were incompatible so that if they were mixed and extruded they would retain their separate natures even though coalescing into a unit.

[1] During the trial, the plaintiffs introduced considerable evidence that the patented product can be sewn through, which apparently they believed was a feature

tending to prove patentability. Plaintiffs, however in their lengthy brief and proposed findings of fact and conclusions of law do not discuss that feature of their product. Moreover, in their brief they admit that feather boning, which preceded their product, can be sewn through. Although, "A patent will protect its holder in his monopoly over whatever use it is capable", Floridin Co. v. Attapulgus Clay Co., 3 Cir., 1942, 125 F.2d 669, 670, 671, the court notes that nowhere in the patent is there a disclosure of the sewing feature.

Plaintiffs' brief refers to the patent in suit in glowing terms, such as, "unexpected and outstanding discovery"; "a synergistic effect if there ever was one"; "unexpected result • • • contrary to the teachings and experience of the plastics industry"; "a giant and radically different stride in the plastics art"; "the discovery of Seckel that the eleven year dogma of the entire plastics art had been wrong"; "in one stroke of experiment buried forever the eleven year misconception and ignorance of an entire industry"; "the hallmark of the greatest of inventions"; "a classic case of the discovery of a new composition"; "unexpected result in the light of these prior contrary teachings and beliefs"; "pushed back the borders of darkness and advanced the frontiers of science"; "taught the art to follow him on a path in a direction 100% opposite to that chartered by the leading scientists of the industry"; and even suggesting an analogy between the Seckel invention and that of Charles Goodyear for vulcanizing rubber. These "findings" are interesting and if true might call for a finding of validity but unfortunately they are not supported by evidence. Language such as this suggests a need for more semantic discipline.

[2] Plaintiffs' brief further suggests that Section 103 of the 1952 Patent Code was intended to reduce or lower the standard of invention as set out in the decisions of our

Supreme Court and other federal courts during the past twenty-five years. It is true that Judge Learned Hand's opinion in Lyon v. Bausch & Lomb Optical Co., 2 Cir., 1955, 224 F.2d 530, sets forth by way of dictum that such was the intention of Congress. However, the Court of Appeals for the Third Circuit in 1953 said in Stanley Works v. Rockwell Manufacturing Co., 203 F.2d 846, 849:

> "On its face Section 103 is merely a codification of decisional patent law. The report of the Senate Committee on the Judiciary (Vol. 38, No. 8, Journal of the Patent Office Society of August 1952) leaves no doubt about this. In part that report states:
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> " 'Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the court. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. * * *' "

[3] In applying the high standards of patentable invention set by our Supreme Court, our task is to draw the line between a small step forward and a giant stride. This process and product are useful, but certainly there has been no giant stride. I conclude, therefore, the patent claims involved here invalid for lack of invention.

[4, 5] As to defendants' request for attorneys' fees, 35 U.S.C.A. § 285 provides that "The court in exceptional cases may award reasonable attorney fees to the prevailing

party." The allowance of attorneys' fees is discretionary. Randolph Laboratories v. Specialties Development Corp., 3 Cir., 1954, 213 F.2d 873, certiorari denied sub nom. Specialties Development Corp. v. Randolph Laboratories, Inc., 1954; Jacquard Knitting Machine Co., Inc., v. Ordinance Gauge Co., Inc., 3 Cir., 1954, 213 F.2d 503. The court does not find plaintiffs guilty of any bad faith, nor is there any other "• • • equitable consideration of similar force which would make it greatly unjust for defendant[s] to take care of its [their] own counsel fees • • •." Jacquard Knitting Machine Co., Inc., v. Ordinance Gauge Co., Inc., 3 Cir., 1954, 213 F.2d 503, 509.

The foregoing opinion shall constitute findings of fact and conclusions of law, as required by Rule 52, Fed.Rules Civ. Proc. 28 U.S.C.A.

An order may be submitted in conformity with the opinion herein expressed.